



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/215,483 12/18/98 THOMAS

S 1452A1

EXAMINER

IM22/1130

PPG INDUSTRIES INC
INTELLECTUAL PROPERTY DEPARTMENT
ONE PPG PLACE
PITTSBURGH PA 15272

ART UNIT PAPER NUMBER

1714
DATE MAILED:

11/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims 1 and 15 recite "wherein the volatile organic content of the coating composition is less than 4.0." and "...less than 3.6" respectively. It is unclear what the units of 4.0 and 3.6 are to be, i.e. weight %, lbs/gallon, etc..

2. Claims 4-6 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A. The formula of claim 4 appears to be incorrect. The specification does not enable the skilled artisan to make the hexavalent and trivalent carbons of this formula. Correction to the apparently intended acrylate skeleton does not constitute new matter, particularly in view of claims 19-20.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 and 11-20 are rejected under 35 U.S.C. 102(a) as being anticipated by US Pat. No. 5834555 Meisenburg et al..

Meisenburg et al. discloses an aqueous coating composition which will inherently possess the instantly claimed VOC and which contains the instantly claimed ingredients and amounts thereof. See column 1, lines 7-46; column 2, lines 54-57; column 3, lines 8-61; column 4, lines 1-67; column 5, lines 1-17 and 38-52; column 6, lines 7-27; column 8, lines 8-25; column 10, lines 29-31; column 11, lines 15-27; column 17, lines 62-67; column 18, lines 1-7; and column 19, lines 12-28.

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5834555 Meisenburg et al. in view of US Pat. No. 5514755 Fenn et al..

Meisenburg et al. discloses an aqueous coating composition which will inherently possess the instantly claimed VOC and which contains the instantly claimed ingredients and amounts thereof. See column 1, lines 7-46; column 2, lines 54-57; column 3, lines 8-61; column 4, lines 1-67; column 5, lines 1-17 and 38-52; column 6, lines 7-27; column 8, lines 8-25; column 10, lines 29-31; column 11, lines 15-27; column 17, lines 62-67; column 18, lines 1-7; and column 19, lines 12-28.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed ingredients and amounts thereof in the composition of

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Meisenburg et al. because the patentee encompasses these ingredients and amounts and they would have been expected to give a coating having the properties disclosed by Meisenburg et al..

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the monomers of the instant claims 9-10 in the polymer of Meisenburg et al. because Meisenburg et al. encompasses the use of the monomers of claim 10 at column 6, lines 20-26, generically encompasses the use of isobornyl (meth)acrylate at column 4, lines 6-10; Fenn et al. teaches the use of isobornyl acrylates in polyacrylate/polyisocyanate coating compositions to give improved properties, and these improved properties would have been expected in the film of Meisenburg et al..


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

November 28, 1999


Patrick Niland
Primary Examiner
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